

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Attorney Docket No. 97,150-C)

In the Application of:)
John Freuhauf)
Serial No.: 09/982,286) Examiner: A. Harris
Filing Date: October 16, 2001) Group Art Unit: 1643
For: Methods for cancer) Confirmation No.: 8043
 prognosis and diagnosis)

**APPLICATION FOR PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. §1.705(d)**

Mail Stop Patent Ext.
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Responsive to the Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) mailed with the Issue Notification on March 1, 2007, Applicants submit this Application for Patent Term Adjustment. Applicants submit the required fee under 37 C.F.R. § 1.18(e) along with this Application for Patent Term Adjustment.

The Determination of Patent Term Adjustment states that the Patent Term Adjustment for this patent is 990 days. Applicants are charged with four incidents of delay, totaling 111 days, while the Office is charged with 1101 days of delay, resulting in the calculated 990 days of Patent Term Adjustment. However, the Applicant disputes 80 of the days attributed to Applicant delay. Thus, Applicant respectfully submits that the proper number of days of Patent Term Adjustment is 1070.

The Applicant was charged 80 days of delay for submission of an IDS early in prosecution of the application. When the application was filed, the Applicant concurrently filed a Preliminary Amendment. On January 17, 2002, the Office issued a technical objection, in the form of a Non-Complaint Amendment, in response to the Preliminary Amendment. The

Applicant filed a complete response to the technical objection in the Notice of Non-Complaint Amendment on February 19, 2002. Thereafter, on May 10, 2002, the Applicant filed the IDS in question. The Office did not mail the first Office action on the merits of the application until June 24, 2005.

It appears that the Office treated the May 10, 2002 IDS as a “submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed” under 37 C.F.R. § 1.704(c)(8), because the IDS was submitted after Applicant’s reply to the Notice of Non-Compliant Amendment. Applicant respectfully submits that the May 10, 2002 IDS does not implicate any provision of 37 C.F.R. § 1.704.

Rule 704(c)(8) specifies that “[s]ubmission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed” will “constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application.” However, the May 10, 2002 IDS was not submitted in response, as a supplemental reply or otherwise, to the Notice of Non-Complaint Amendment. Instead, the IDS was submitted to comply with the 37 C.F.R. § 1.56 duty of disclosure, and was filed within the time limits permitted under 37 C.F.R. § 1.97(b) (“An information disclosure statement shall be considered by the Office if filed by the applicant within any one of the following time periods: (3) Before the mailing of a first Office action on the merits”). Moreover, it cannot be said that the Applicant’s submission of the IDS delayed processing or examination of the application. Applicant’s response to the Notice of Non-Complaint Amendment was merely a response to a technical requirement by the Office. Examination on the merits of the application did not begin for more than *three years* after the submission of the response to the Notice of Non-Complaint Amendment and the IDS in question. Thus, the Applicant respectfully submits that it was an error to attribute any “Applicant delay” to the filing of the May 10, 2002 IDS.

It is Applicant’s position that the IDS filed in this application does not qualify as “Applicant delay” under any of the provisions of Rule 704. Moreover, Rule 704(d) should not be used as a basis for bringing an otherwise timely IDS submission under the “Applicant delay” umbrella of Rule 704.

In order to comply with 37 C.F.R 1.704(d), applicants are required to certify that:

1. the references cited in the IDS were first cited in any communication from a foreign patent office in a counterpart application, and
2. the communication from the foreign patent office was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement.

But an Applicant is not required to make such certifications if the IDS is filed before the first action on the merits. 37 C.F.R 1.97(b). To allow Rule 704 to convert a timely and proper IDS submission into a “supplemental reply or other paper” which counts as “Applicant delay” improperly penalizes an Applicant. This is especially true in this case, where the IDS submission clearly did not delay processing or examination of the application.

In light of the foregoing, Applicants respectfully request reinstatement of the 80 days charged as Applicant delay associated with the filing of the May 10, 2002 IDS. If a telephone conference would expedite the prosecution of this Application for Patent Term Adjustment, please contact the undersigned attorney as indicated below.

Respectfully submitted,

Date: June 1, 2007



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